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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,786	09/26/2001	Ben C. Platt	7093-112	3040

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EXAMINER

TADESSE, YEWEBDAR T

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,786

Applicant(s)

PLATT ET AL.

Examiner

Yewebdar T Tadesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9,12-19 and 28 is/are rejected.
- 7) ☒ Claim(s) 20-27 and 29-32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04152002. 6) ☐ Other:

DETAILED ACTION

Information disclosure

1. All listed under non-Patent literature documents and the PCT/US00/41650 listed under foreign patent documents, which are filed by the applicant on November 27/2001, are not considered by the examiner (see line drawn through documents) in the IDS. There is no record of this PCT application number in our database system.

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species of the claimed invention: species A, drawn to a method for modifying the refractive power of a light lens as an intraocular lens implanted in an eye (claims 5-6), species B, drawn to a method for modifying the refractive power of a light lens as a customized contact lens (claims 7 and 10-11) and species C, drawn to a method for modifying the refractive power of an optical system e.g. microscopes, telescopes, camera lenses, etc. (claim 8).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 9, and 12-32 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Papalas Michael (Reg. # 40,381) on 01/06/2004 a provisional election was made with traverse to prosecute the invention of species A, claims 5-6). Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-8 and 10-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnel, Jr. (US 5,549,668) in view of Lai et al (US 6,575,572). O'Donnell discloses (see Abstract, column 6, lines 36-62 and Figs 5-6) a method for modifying (changing) the refractive power of a light adjustable lens in the optical system, with lens modifying radiation (laser energy varying the curvature of the intraocular lens implant) comprising

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aligning a source of the modifying radiation so as to impinge the radiation onto the lens (directing laser energy 16 at different direction to the implanted lens -this laser energy capable of having pattern) and controlling the quantity of the impinging radiation (applying laser energy as required to increase or decrease the refractive powder of the implanted lens for vision correction). O'Donnel is silent concerning the step of measuring the optical aberration of the lens. However it is well known in the art to measure system's or eye's lens vision error before performing any correction procedure; for instance Lai et al discloses (see Abstract and column 2, lines 21-25) a method for measuring optical aberrations of an eye to determine optical irregularity. It would have been obvious at the time the invention was made to include the essential step of measuring the optical aberration in O'Donnel to gain vital information about the optical abnormality of the lens so as correction procedures follow according to the measurement.

8. Claims 1-6, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jethmalani et al (US 6,450,642) in view of Lai et al (US 6,575,572). As to claims 1 and 5-6, Jethmalani et al teaches (see Figs 1-2 and columns 2-3, lines 30-67 and 1-25 respectively) optical elements (intraocular lenses) capable of post-fabrication power modification by performing irradiation procedure, wherein precisely controlled energy source (light) is exposed to the region of the optical element (lens) to attain the desired lens properties. Jethmalani et al also depicts (see Fig 1) part of the lens at the center and the entire lens irradiated by the hv (capable of having patterns).

Jethmalani is silent concerning the step of measuring the optical aberration of the lens. However it is well known in the art to measure system's or eye's lens vision error before performing any correction procedure; for instance Lai et al discloses (see Abstract and column 2, lines 21-25) a method for measuring optical aberrations of an eye to determine optical irregularity. It would have been obvious at the time the invention was made to include the essential step of measuring the optical aberration in Jethmalani et al to gain vital information about the optical abnormality of the lens in order to perform the correction procedures. As to claims 2-4 and 28, In Jethmalani, the duration and the intensity (amount) and the duration of irradiation are controlled (see Fig 1, column 3, lines 2-12 and column 2, lines 11-13) and the step of irradiating the entire lens is performed to lock –in the desired lens property by polymerizing the refractive modulating composition (see column 3, lines 12-20 and column 8, lines 4-7). In Jethmalani et al, the radiation (hv) irradiating the entire lens is capable of being patterned radiation. As to claim 19, see for Fig 1 for the patterns of the lens exposed to different amount of radiation in modifying the refractive power of the lens (with aberration).

9. Claims 9 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jethmalani et al (US 6,450,642) and Lai et al (US 6,575,572) as applied to claim 1 above, and further in view of Swinger et al (US 6,325,792), Yasuda et al (US 4,755,056) and Appeldorn et al (US 5,432,876). Jethmalani et al lacks teaching what type of light source is the impinging radiation. Swinger et al teaches the use of ultraviolet laser to

modify the refractive power of the intraocular lens system (see column 28, lines 13-21 and column 35, lines 18-23). Yasuda et al teaches (see column 1, lines 10-45) a xenon arc lamp and a deuterium discharge lamp as sources of UV light. Appeldorn et al teaches (see column 5, lines 62-68) light sources for an illumination device including continuous and pulsed light sources such as laser diodes, lamps emitting in the UV. It would have been obvious at the time the invention was made to emit UV light onto the lens from the suitable sources such as shown by Swinger et al, Appeldorn et al or Yasuda et al in Jethmalani to effect the desired action onto the lens by transmitting the light.

Allowable Subject Matter

10. Claims 20-27 and 29-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: As to claim 20, Marchant et al (US 6,353,502) discloses a Vertical Cavity Surface Emitting Laser (VCSEL) used to generate a pattern for optical tape recording. Marchant et al's device is not used for modifying the refractive power of a light adjustable lens. Prior art of record does not disclose or suggest a method of modifying the refractive power of a light adjustable lens comprising, among others, aligning a source of the modifying radiation so as to impinge the radiation in a pattern, wherein an

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ultraviolet vertical-cavity surface emitting laser array is used to generate the pattern and project it onto the surface of the light adjustable lens. As to claims 21-26, 29-30 and 32, Della Vecchia et al (US 6,648,473) teaches Liquid -Crystal Spatial Light Modulator as one of the known methods for using adaptive optics to compensate for aberrations of the human eye (see column 3, lines 5-17), however Della Vecchia et al does not teach how the radiation pattern is obtained. Prior art of record does not disclose or suggest a method of modifying the refractive power of a light adjustable lens comprising, among others, aligning a source of the modifying radiation so as to impinge the radiation in a pattern, wherein the pattern is obtained by projecting UV light through an apodizing filter or a spatial modulator or a digital light processor or by photo feedback. As to claims 27 and 31, Swinger et al (US 6,325,792) teaches (see claim 1, column 2, line 17 a laser-method for intraocular surgery using wavelength in the range of 400-1900 nm and 200 nm of Blum et al (see column 1, line 1-3). Prior art of record does not disclose or suggest a method of modifying the refractive power of a light adjustable lens comprising, among others, aligning a source of the modifying radiation so as to impinge the radiation in a pattern, in which the UV light has a wave length in the range of 350-380 nm and is applied at an intensity of 9.75-12.25 mw/cm².

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T Tadesse whose telephone number is (571) 272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4: 30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Lowenthal P.O.
YTT

A handwritten signature in cursive script, appearing to read "Michael Colaianni", with a horizontal line extending from the end.

**MICHAEL COLAIANNI
PRIMARY EXAMINER**